

REMARKS

Claims 1-177 are pending in the application. Claims 8 and 9 have been amended to more particularly point out and distinctly claim the subject matter of the invention. Claims 110, 111, 173, 174 and 177 have been amended to correct a grammatical error. Claim 111 has been amended to distinguish claim 111 from claim 110. Claim 160-177 have been amended to claim a method rather than a vote. Claims 1, 48, 72, 117, 134, 140, 146, 153 and 160 have been amended to further define the present invention. The remaining claims remain unchanged from their original versions.

Objections to the Specification

The Examiner objected to the specification for certain informalities, which have been corrected in accordance with the Examiner's remarks. Reconsideration and withdrawal of the objection to the specification is respectfully requested.

Claims 8, 9, 28, 29, 104, 105, 110, 111, 165 and 166 Are Not Duplicates of Each Other

The Examiner objected to claims 8, 9, 28, 29, 104, 105, 110, 11, 165 and 166 as being duplicates of Claim 110. However, the Examiner's additional remarks seem to indicate the objection relates to these claims being duplicates of each other. The Examiner contends that claims 8 and 9 include only the difference in the term "rendering" versus "communicating" certain information. The Applicant notes that the term "rendering" relates to functionality in creating a visual display regarding the information, whereas communicating relates to delivering the information. Each term is distinct and not necessarily overlapping in scope, and as such these claims are not duplicates of each other but recite distinct embodiments that are of different scope.

With regard to claims 28 and 29, the Examiner notes that claims 28 and 29 include only the difference that the received weight is "from the user." Even assuming *arguendo* that the Examiner's contention that the received weight must originate from the user, the scope of these two claims is different and are therefore not duplicates.

With regard to claims 104 and 105, these claims are not redundant for the same reasons as claims 28 and 29.

The Examiner further objected to claims 110 and 111 because these claims are exact duplicates. The Applicant has amended these claims to be different by inserting the phrase "from the shareholder" and as amended, these claims are not redundant for the same reasons as claims 28 and 29. Moreover, the Examiner objected to claims 110 and 111 as including certain informalities, which have been corrected.

Reconsideration and withdrawal of the objection to these claims is therefore respectfully requested.

Claims 8 and 9 Satisfy 35 U.S.C. § 112, ¶ 2

The Examiner rejected claims 8-9 under 35 U.S.C. § 112, ¶ 2 as failing to particularly point out and distinctly claim the subject matter, which Applicant regards as the invention. The Applicant has amended claims 8 and 9 in accordance with the Examiner's remarks. Reconsideration and withdrawal of the rejection of these claims is therefore respectfully requested.

Claims 160-177 Satisfy 35 U.S.C. § 101

The Examiner rejected claims 160-177 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Examiner contends that these claims are directed to non-statutory subject matter because the claimed invention is a vote. While the Applicant respectfully disagrees with the Examiner's contention, the Applicant has amended these claims in accordance with the Examiner's remarks to expedite issuance of a patent. Therefore, the Applicant respectfully submits that claims 160-177 satisfy 35 U.S.C. § 101 and reconsideration and withdrawal of the rejection of these claims is therefore respectfully requested.

Claims 1-177 Satisfy 35 U.S.C. § 101

The Examiner rejected claims 1-177 under 35 U.S.C. § 101 as being lacking patentable utility. The Examiner contends that these claims lack utility because the claimed invention "generates votes that are invalid" because the vote must be based on an informed decision, which the Examiner contends the present invention precludes. The Applicant respectfully disagrees with the Examiner's characterization of the claimed invention.

The Examiner has taken the position that “the prior art systems require shareholders’ attention to the proxy statements because for a vote to be valid, the shareholder must make the vote based on an informed decision.” Yet, the Examiner has provided no reference or authority supporting this position. As such, the Applicant hereby formally requests that the Examiner cite some authority for this position.

As an aside, it is worth noting that an “examiner may take official notice of *facts* outside of the record which are capable of *instant and unquestionable demonstration* as being ‘well-known’ in the art.” M.P.E.P. § 2144.03 [emphasis added] citing In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970) and In re Seifreid, 407 F.2d 897, 160 USPQ 804 (CCPA 1969). Furthermore, the M.P.E.P. states: “If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position.” *Id.*

As the Examiner has essentially based a rejection for lack of utility on an assertion that a shareholder must make a vote based on an informed decision for the vote to be valid, which assertion is not supported by any reference, this can only be an *implied* taking of Official Notice. As such, the Applicant formally requests that the Examiner cite a reference in support of his position.

“An invention has a well-established utility if (i) a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention (e.g., properties or applications of a product or process), and (ii) the utility is specific, substantial, and credible.” M.P.E.P. § 2107. When reviewed in light of this standard, the claimed invention has such utility. The claimed inventions described in the present application enable a shareholder to vote more responsibly than heretofore was possible by aligning with organizations that perform the necessary research to understand the issues at stake. Presently, corporate shareholders are sent corporate voting forms, which are then returned by shareholders who cannot spend the time necessary to understand completely the issues regarding a given election, particularly given the relatively small amount of resources that a particular shareholder may have invested in the corporation. Such votes cannot be considered informed decisions.

Moreover, this problem becomes exacerbated by portfolio trading systems, such as those of the current inventor, that enable users to trade hundreds of stocks with a simple click of a mouse button. With diverse holdings in one’s portfolio, a shareholder may only own a small

number of shares of a given security, which makes it impractical for such a shareholder to research the issues surrounding a given corporate vote. Thus, the present invention makes it possible to obtain advice regarding a given corporate vote and to follow this advice, as desired. Voting based on another's advice does not invalidate the vote, as the vote still originates with the shareholder. Simply because the shareholder sets forth a deterministic process by which the vote should be processed cannot by itself make such a corporate vote invalid. The vote still originates with the shareholder and remains under the control of the user.

As an applicant need only provide one credible assertion of specific and substantial utility for each claimed invention to satisfy the utility requirement, M.P.E.P. § 2107, the claimed inventions in the present application satisfy the utility requirement because they enable shareholders to vote their shares more easily and quickly. Therefore, the Applicant respectfully submits that claims 1-177 satisfy 35 U.S.C. § 101 and reconsideration and withdrawal of the rejection of these claims is therefore respectfully requested.

Claims 146-149 Are Patentable Over *PROXYEDGE 2000*

The Examiner rejected claims 146-149 under 35 U.S.C. § 102(b) as being anticipated by *ProxyEdge 2000*, which was submitted by the Applicant [hereinafter "*ProxyEdge 2000*"]. Essentially, the Examiner contends that *ProxyEdge 2000* discloses all of the elements of the claims at issue. The Applicant respectfully disagrees with the Examiner's characterization of this reference vis-à-vis the claims at issue. These claims include the recitation that the service votes the user's shares "in accordance with preferences of the user . . ." *ProxyEdge 2000* fails to disclose using a user's preferences to determine how to vote the user's shares. As such, *ProxyEdge 2000* cannot anticipate claims 146-149. Reconsideration and withdrawal of the rejection of claims 146-149 is therefore respectfully requested.

Claims 1-7, 10, 12, 13, 15-17, 22, 48-50, 57, 72-81, 87, 89, 90, 92-94, 99, 117-119, 122, 126, 134, 135, 138-141, 144, 145, 160, 161, 162, 163, 164 and 168 Are Patentable Over *PROXYEDGE 2000* and *HOSKEN*

The Examiner rejected claims 1-7, 10, 12, 13, 15-17, 22, 48-50, 57, 72-81, 87, 89, 90, 92-94, 99, 117-119, 122 AND 126, 134, 135, 138-141, 144, 145, 160, 161, 162, 163, 164, 168 under

35 U.S.C. § 103(a) as being unpatentable over *ProxyEdge 2000* in view of U.S. Patent No. 6,438,579 to Hosken [hereinafter "Hosken"]. Essentially, the Examiner contends that *ProxyEdge 2000* discloses all of the elements of the claims at issue, except for voting based on used-specified preferences, for which the Examiner cites Hosken. The Examiner then contends that it would have been obvious to combine these references to arrive at the claimed inventions.

With all due respect, the Examiner has failed to make a *prima facie* case of obviousness because he has failed to show a suggestion or motivation to combine these teachings. "To establish a *prima facie* case of obviousness there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings . . . The teaching or suggestion to make the claimed combination . . . must . . . be found in the prior art and not based on applicant's disclosure." M.P.E.P. § 706.02(j)(D) *citing In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Examiner contends that applying computer-based decision making based on user set preferences to corporate voting would have been obvious because it would automate what was an otherwise manual activity. This simply mischaracterizes the claimed inventions. Without the present invention, there is no mechanism in the prior art cited or otherwise as to how a shareholder can set preferences, and the kind of preferences one might set that would lead to a determination as to how to vote corporate shares. Thus, the Examiner's motivation to combine fails to capture the resulting claimed invention.

Furthermore, neither of these references teaches nor suggests the use of voting recommendations as a basis for determining how to vote the user's shares. As the entire claimed invention is not included in either *ProxyEdge 2000* or Hosken, a *prima facie* case for obviousness cannot be made because the combination of the *ProxyEdge2000* and Hosken, even assuming *arguendo* they can be combined, does not disclose or suggest all elements of Applicant's rejected claims; hence claims 1-7, 10, 12, 13, 15-17, 22, 48-50, 57, 72-81, 87, 89, 90, 92-94, 99, 117-119, 122, 126, 134, 135, 138-141, 144, 145, 160, 161, 162, 163, 164 and 168 are patentable over *ProxyEdge 2000* and Hosken, either taken alone or in combination. Reconsideration and withdrawal of the rejection of claims 1-7, 10, 12, 13, 15-17, 22, 48-50, 57, 72-81, 87, 89, 90, 92-94, 99, 117-119, 122, 126, 134, 135, 138-141, 144, 145, 160, 161, 162, 163, 164 and 168 is therefore respectfully requested.

CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application is in clear condition for allowance. Issuance of a Notice of Allowance is earnestly solicited.

The Office is authorized to charge the two-month small entity extension of time fee of \$205.00 to Deposit Account No. 11-0600. The Office is hereby authorized to charge any additional fees required under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayments to Deposit Account No. 11-0600. A duplicate of this sheet is provided for this purpose.

The Examiner is invited to contact the undersigned at 202-220-4200 to discuss any matter regarding this application.

Respectfully submitted,
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